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No. 84-1943

IN THE

Supreme Court of the United States

October Term, 1985

DONALD M. WOODS,
Petitioner,

v.

WILLIAM S. TSUCHIYA,
Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF IN SUPPORT OF PETITION FOR CERTIORARI

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Tsuchiya's brief in opposition to the petition raises two new arguments to which a very short response seems appropriate.

ARGUMENT

1. The first new argument raised in Tsuchiya's brief is the keystone of his very narrow "response" to the petition's showing of deprivation of patent rights without due process of law.

At page 3 of the brief in opposition it is stated:

> "Inasmuch as the . . . counts of the present interference have all been found to be patentable, whereas the proposed count was not an acceptable claim, we cannot agree with Woods that the proposed count and the present interference counts are similar."[1]

There is a fatal fallacy in this argument: an incorrect implication that the difference between the proposed count being "not . . . acceptable" to the Patent Office[2] and the present counts being held patentable, is due to dissimilar subject matters. This is not the case.

It was conceded by both parties in the first interference, and the Examiner agreed, that the line feed count proposed by Woods literally read on a prior Pittinger patent, applied for on October 15, 1974, before the Woods and Tscuhiya filing dates. That count thus would be anticipated and unpatentable if Pittinger was an effective reference. Woods, however, argued that Pittinger was not an effective reference against either party because both Woods and Tsuchiya had sworn to dates for their first work which were prior to Pittinger's filing date. Tsuchiya disagreed with Woods' argument, contending that the prior

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[1] This statement follows a misquotation (brief in opposition, page 2), plainly inadvertent, from the Court of Appeals opinion, a quotation which (when corrected) is to the effect that Woods conceded the proposed line feed count in the first interference and the line feed counts in this second interference are "patentably distinct". The error is in the next to the last word of Tsuchiya's quotation; this word should be "present" instead of "first". Tsuchiya on page 4 of his brief in opposition uses the correct wording.

[2] By "not . . . acceptable" Tsuchiya means, as his brief earlier states (page 2 n.3) that the proposed count "was held by the Examiner to be unpatentable, and was never added to the interference".

"swearing back" by the parties applied only to previously considered subject matter (involving cutting head construction) which was different from that of the proposed count (line feed mechanisms, broadly). The Examiner accepted Tsuchiya's position on this in denying Woods' motion to amend (also ruling there could be no reconsideration of his holding). After Woods had judgment entered against him in the first interference, he resumed ex parte prosecution, again sought broad line feed claims and filed another affidavit swearing back of Pittinger's filing date, an affidavit which this time was accepted as directed to the claimed line feed subject matter, leading to the later allowance to Woods of various line feed claims, including those in the second interference.

Thus, Tsuchiya's reliance on the different Patent Office holdings against the proposed line feed count in the first interference and in favor of the line feed counts now in this interference, in no way contradicts Woods' position that the line feed subject matter of the proposed count in the first interference and the line feed subject matter of the counts in the present interference are substantially the same.

Nor is this similarity contradicted by Tsuchiya's reliance on any "concession" by Woods that the proposed count and the counts in the present interference are "patentably distinct". Making the comparison suggested by Tsuchiya (brief in opposition, page 2) between the proposed count (petition, page A-4) and, for example, "representative" present count 2 (petition, pages A-2 to A-3), one can readily see that the claims are indeed substantially similar in scope,[3] with count 2 "patentably distinct" from the proposed count in the sense that count 2 contains limitations that the feed means uncoil the line "selectively" and "during the cutting of vegetation". Clearly, the position taken by Tsuchiya in the first interference, followed by the Examiner, in denying Woods' motion to amend, also

[3] The scope of present count 2 is, in effect, limited by law to feed means "secured against rotation" with the cutting head (see petition, page 8 n.4).

effectively foreclosed from that interference the similar line feed claims in the present interference. Under the circumstances, we believe it to be palpably unfair, and a denial of due process, to use the first interference as a basis in the second interference for depriving Woods of the line feed claims he finally obtained and for awarding those claims to Tsuchiya, who successfully fought against the introduction of any line feed subject matter in the first interference.

2. The second new argument raised in Tsuchiya's brief in opposition (pages 5-6) is that the award of priority in the first interference could not have been solely on an "ancillary matter" within the meaning of Patent Office Rule 257 because the "common situation" for the application of that Rule is a dissolution of the first interference and an award of priority based on the other party's inability to support the count. According to Tsuchiya, that is

> "the conventional 'ancillary matter' and is tantamount to a ruling that the interference never should have been declared in the first place"

and, says Tsuchiya, since "the present interference is not such a situation", Rule 257 cannot apply.

But there is nothing in Rule 257 to support this narrow interpretation, and there is authority directly to the contrary on this very point (see, e.g., *Ex parte Voris*, 92 USPQ 47 (PO Bd App. 1951), where the senior party's abandonment of the first interference was held under Rule 257 not to estop him in a later interference on patentably distinct subject matter), and even the Court of Appeals' view of Rule 257 is not in accord with this new argument of Tsuchiya's (see petition, page 14 n.8).[4]

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[4] Actually, Woods' inability to contest the subject matter of feed means in the first interference is akin to having had that interference dissolved, and "never . . . declared in the first place", with respect to the count he proposed. As to Tsuchiya's related argument that the Court of Appeals in the present case (in holding Rule 257 did not apply) also indicated that the award in the first interference could not be viewed, in effect, as on the merits (see petition, pages 12-14).

CONCLUSION

For the reasons set forth in the petition and this reply brief, a writ of certiorari should issue in this case.

Respectfully submitted,

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